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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD A. IVE

Appeal No. 1999-1491
Application No. 08/386,670

ON BRIEF

Before CALVERT, FRANKFORT and McQUADE, Administrative Patent Judges

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 3 and 5 through 23. Claim 4 has been canceled. We affirm-in-part.

BACKGROUND

Appellant's invention relates to a cushion (10) for supporting an infant (12) on a support surface (16) while changing the infant's diaper with the objective of ensuring the safety and security of the child. To this end, appellant has invented a cushion which includes a foam padding arrangement (18) and a casing (24). The upper supporting surface of the padding is V-shaped in cross-section so as to form a trough or channel in which the infant is supported without the fear of the child rolling off the pad. The casing (24) includes a top panel (40) and first and second bottom panels (42, 44). Side and end casing panels (46, 48) join the top panel (40) to the bottom panels (42, 44) with the end panels (48) forming pockets (50, 52) in order to allow first and second pad sections (20, 22) of the padding arrangement to be easily removed from the casing (24) when the casing becomes soiled. The first and second pad sections are divided into a pair of foam pieces in order to permit folding to take place around a transverse line "T", thus lending a portability feature to the invention. The infant is secured

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the pad by an adjustable elasticized strap (66). The cushion itself is secured to the support surface by an anchoring structure (80) which inhibits sliding of the pad along the support surface. A copy of representative claim 1 appears below:

1. A cushion adapted to support an infant on a support surface of a support structure, comprising:

(a) a pad having a lower surface, an upper surface and a pair of longitudinally extending side surfaces joining the lower surface and the upper surface, the upper surface being formed in a trough-shaped configuration to define a channel whereby the infant may be supported therein;

(b) a casing sized and adapted to receive said pad in an interior thereof, said casing including a bottom panel extending along the lower surface of said pad, a top panel extending along the upper surface of said pad and a pair of side panels each extending along a respective side surface of said pad; and

(c) a restraining strap connected to said casing and positioned to be extended transversely across the channel thereby to releasably secure the infant therein.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

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|--------------------------|-----------|--------------|
| Kelly | 2,598,999 | June 3, 1952 |
| Solin | 3,319,273 | May 16, 1967 |
| Burpo | 3,811,140 | May 21, 1974 |
| Mueller et al. (Mueller) | 3,871,637 | Mar. 18, |

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|-----------------|-----------|--------------|
| 1975 | | |
| Ledesma | 4,579,111 | Apr. 1, 1986 |
| Deck | 5,161,273 | Nov. 10, |
| 1992 | | |
| Emelien | 1,449,012 | July 4, 1966 |
| (French Patent) | | |

As stated in the final rejection (Paper No. 6), claims 1 through 3 and 5 stand rejected under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck; claim 6 stands rejected under 35 U.S.C. § 103(a) over Ledesma in view of Deck as applied to claim 5 and further in view of Emelien; claim 7 stands rejected under 35 U.S.C. § 103(a) over Ledesma in view of Deck as applied to claim 1 and further in view of Mueller et al; claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) over Ledesma in view of Deck as applied to claim 1 and further in view of Kelly; claims 10, 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck as applied to claim 1 above and further in view of Solin; claims 13 through 17 stand rejected under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck and Solin¹;

¹Claim 20 is not included in the first statement of the rejection. However, the examiner refers to it in the body of the rejection of claims 13 through 17. We will therefore

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claims 18 and 19 stand rejected under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck and Solin as applied to claim 17 and further in view of Mueller; claim 21 stands rejected under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck and Solin as applied to claim 17 and further in view of Kelly; claim 22 stands rejected under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck and Solin as applied to claim 13 and further in view of Burpo; and claim 23 stands rejected under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Kelly.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 6, mailed September 24, 1996) and the examiner's answer (Paper No. 12, mailed August 29, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 11, filed April 23, 1997) and reply brief (Paper No. 13, filed October 29, 1997) for the

assume that claim 20 is rejected with claims 13 through 17.

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arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking at page 7 of the brief, we note that appellant has indicated that independent claim 1 as well as dependent claims 2, 3, 5 through 7 and 10 stand together; that dependent claims 8 and 9 stand together; that claims 11 and 12 stand together; that independent claim 13 as well as claims 14 through 16 stand together; that claims 17 through 20 stand together; and that each of claims 21 through 23 are separately patentable.

Turning first to the examiner's rejection of claim 1

under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck, we observe that Ledesma teaches a cushion or pad (10) that is adapted to support a user on a support surface of a support structure (12). As readily seen in Figure 1, the cushion of Ledesma includes pads (14, 16) which define a trough-shaped channel in the upper surface thereof, whereby the user may be supported therein. The cushion of Ledesma also includes a casing (20) for receiving the pads (14, 16). The only feature of appellant's cushion defined in claim 1 on appeal that is lacking in Ledesma is the restraining strap which extends transversely across the pad and releasably secures the user in the trough-shaped channel. The examiner has taken the position that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to provide a restraining strap on Ledesma's cushion which extends transversely across the cushion in view of Deck who discloses a neonatal cradle (11) which includes a foam channel-shaped pad (19) which has a restraining strap including a pair of strap portions (26, 27) extending across the channel. The appellant has argued (brief, pages 12 and 13) that a restraining strap would be cumulative to Ledesma's

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device since Ledesma already incorporates restraining straps (24). Furthermore, appellant urges that adding a restraining strap across Ledesma's channel would interfere with access to the individual's back and lumbar region during surgery.

We disagree with appellant. The Court of Appeals for the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals, have provided us with the following guidance for evaluating what would have been obvious within the meaning of 35 U.S.C. § 103. The question under 35 U.S.C. § 103(a) is not merely what the references expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of the references, it is not necessary that such to be found in the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of

ordinary skill in the art without any specific hint or suggestion in the particular reference. See In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of the artisan rather than lack thereof. In re Sovish, 769 F.2d 738, 743, 226, USPQ 771, 774 (Fed. Cir. 1985). In combining the teachings of Deck with Ledesma, we note that Deck discloses that the cushion is for supporting critically ill neonates during prolonged hospital confinement (col. 1, lines 11-16) and furthermore, that Deck's invention may also be used for performing medical procedures with a minimum of handling of the neonate (col. 3, lines 16-35). An exemplary procedure is radiography, wherein one of ordinary skill in the art would know that keeping the infant in a singular position is important to obtaining accurate radiographs. With this teaching in mind and the teaching in Ledesma (col. 1, line 31) that the support cushion therein may be used for "a number of operations," we agree with the examiner that it would have been obvious to one of ordinary skill in the art to provide a securement strap transverse to Ledesma's cushion (10) in order to provide added securement to Ledesma's device. One should

note that Ledesma does not design his pad to be age-specific and therefore, it is likely that it would be used for a small child as well as adults. In such a case, a transverse strap would be an effective addition to the cushion for providing restraint of the user. Contrary to appellant's assertions, we consider that it would have been well within the ordinary skill of one in the art and therefore obvious to position the strap in a location that does not impede the surgical process. Furthermore, appellant's claim 1 does not recite specific parameters for the positioning of the infant. In the final analysis, it is our opinion that the examiner has established a prima facie case of obviousness in the rejection of claim 1 as being obvious over Ledesma in view of Deck. We therefore affirm the examiner's rejection of claim 1. Since claims 2, 3, 5 through 7 and 10 are grouped with claim 1 and therefore fall with claim 1, we affirm the examiner's rejection of those claims also.

Regarding claim 8 on appeal, the examiner has taken the position that the teachings of Kelly would have made it obvious to one of ordinary skill in the art at the time of appellant's invention to provide anchoring straps to Ledesma's cushion in order to securely hold the cushion on top of the operating table (12). Appellant argues (brief, pages 16 and 17) that there would be no reason to modify Ledesma as suggested since first, Kelly's anchoring structure is merely looped around, but not secured to the support structure as required in claim 8. Secondly, appellant argues, there would be little motivation to anchor a surgical pad like that of Ledesma to a support structure since the patient is unconscious and in all likelihood is an adult and therefore, the danger of the cushion sliding is minimal. We agree with the examiner for the following reasons. First, we consider Kelly's anchoring structure (16-19) which is looped around the support structure to be, by its broad definition, "secured" to both the crib structure and the support structure since once the loop is tightened, it holds the structure to which it is affixed (the crib) in place without sliding (see col. 2, lines 8-16). Unpatented claims should be given the broadest

reasonable interpretation consistent with the specification and limitations of the specification should not be read into the claims where no express statement of limitation is included in the claim. See In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). Appellant has not specifically claimed any particulars of the securement arrangement. "Secured" is simply defined as: to be made fast² and certainly, Kelly's teaching meets that definition. Furthermore, we find adequate motivation to secure Ledesma's pad to the support structure in view of Kelly's teachings, especially from the standpoint of safety, in the event that a patient under anesthesia needs to be maneuvered without danger of the cushion sliding, or that the patient partially regains consciousness and has some involuntary movement. We affirm the examiner's rejection of claim 8. Since claim 9 falls with claim 8, we affirm the rejection of claim 9 also. Appellant has stated that independent claim 23 is separately patentable, but argues the rejection of claim 23 with claim 8. Since the issue appellant argues is the anchoring structure and is the

² Webster's Ninth New Collegiate Dictionary, 1990.

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same issue that pertains to claim 8, we also affirm the
examiner's rejection of claim 23.

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With regard to the examiner's rejection of claim 11 as being obvious over Ledesma in view of Deck and further in view of Solin, the examiner recognizes that Ledesma lacks first and second pad sections as claimed and the claimed first and second pockets of the casing which are adapted to receive the first and second pad sections. However, although the examiner relies on Solin to "bridge the gap" between the claimed invention and the patent to Ledesma, the examiner has failed to explain why one of ordinary skill in the art would have divided the cushion (10) of Ledesma transversely of the pyramidal pad members (16) and also failed to point out any part of Solin's disclosure which discusses the presence of pockets. Like appellant, we see no reason, teaching or suggestion in Solin which would have led one of ordinary skill in the art to divide the cushion of Ledesma in the particular manner required in claim 11 on appeal. Moreover, while the appellant provides no direct comment regarding the presence or absence of pockets in the prior art applied by the examiner, we must reverse the examiner who explicitly pointed out the deficiency in the primary reference and then failed to establish a prima facie case of obviousness since the missing

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feature was never taught. Accordingly, we reverse the examiner's rejection of claim 11. Since claim 12 depends from claim 11 and stands or falls with claim 11, we reverse the rejection of claim 12 also.

The examiner also rejects independent claim 13 as being unpatentable over Ledesma in view of Deck and Solin. Since claim 13 also recites the particulars with regard to the folding of the cushion about a line transversely of the trough-shaped pads sections and first and second pockets of the casing being adapted to receive the first and second pad sections, the comments set forth in the previous paragraph apply equally to claim 13 and thus, we reverse the examiner's rejection of claim 13. We also reverse the examiner's rejections of claims 14 through 22, all of which depend from claim 13.

CONCLUSION

The rejection of claims 1 through 3 and 5 under 35 U.S.C.

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§ 103(a) as being obvious over Ledesma in view of Deck is
affirmed.

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The rejection of claim 6 under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck as applied to claim 5 and further in view of Emelien is affirmed.

The rejection of claim 7 under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck as applied to claim 1 and further in view of Mueller is affirmed.

The rejection of claims 8 and 9 under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck as applied to claim 1 and further in view of Kelly is affirmed.

The rejection of claim 10 under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Ledesma in view of Deck and further in view of Solin is affirmed.

The rejection of claims 11 and 12 under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck as applied to claim 1 above and further in view of Solin is reversed.

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The rejections of claims 13 through 17 and 20 under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck and Solin is reversed.

The rejection of claims 18 and 19 under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck and Solin as applied to claim 17 and further in view of Mueller is reversed.

The rejection of claim 21 under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck and Solin as applied to claim 17 and further in view of Kelly is reversed.

The rejection of claim 22 under 35 U.S.C. § 103(a) as being obvious over Ledesma in view of Deck and Solin as applied to claim 13 and further in view of Burpo is reversed.

The rejection of claim 23 under 35 U.S.C. 103(a) as being obvious over Ledesma in view of Kelly is affirmed.

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No period for taking any subsequent action in connection
with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

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| IAN A. CALVERT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CHARLES E. FRANKFORT |) | APPEALS AND |
| Administrative Patent Judge |) | INTERFERENCES |
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| |) | |
| |) | |
| JOHN P. McQUADE |) | |
| Administrative Patent Judge |) | |

CEF/dal

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TIMOTHY J. MARTIN
9250 WEST 5TH AVENUE
STE. 200
LAKEWOOD, CO 80226